

REMARKS

Claims 19-22, 26, 33-35 and 39-45 are pending in the instant application. Applicants note that during the discussion with the Examiner on November 2, 2004, the Examiner clarified her rejection based on Kayyem by stating that “conductive oligomers” and the claimed “insulators” are relative terms and thus examination would be facilitated by incorporation of a chemical structure to define “insulator” more definitely. Applicants have complied with this request and therefore reconsideration of the pending claims in light of the amendments presented above and the comments presented below is requested. Support for the instant amendments can be found at page 36 (“insulators are alkyl or heteroalkyl oligomers”), page 37 (disclosing insulators comprising: $-(CH_2)_n-$, $-(CRH)_n-$, $-(CR_2)_n-$, ethylene glycol and ethylene glycol derivatives using other heteroatoms in place of oxygen), and Example 6 (disclosing an insulator wherein in “n” is 16).

35 U.S.C. § 102(e)

Claims 19-31 and 33-40 stand rejected under 102(e) as anticipated by Kayyem et al., U.S. Patent No. 6,096,273 (“Kayyem”). In particular, the Examiner has asserted that Kayyem teaches nucleic acid attachment to electrodes via conductive oligomers, and that since conductive oligomer and insulator are relative terms, the insulators currently claimed (for attachment of nucleic acids to electrodes) must be defined in such a way as to exclude the conductive oligomers of Kayyem. Applicants submit that the instant amendment sufficiently defines insulators to exclude the conductive oligomers of Kayyem.

For an anticipation rejection under 35 U.S.C. §102(e) to be proper, a single reference must expressly or inherently disclose each and every element of a claim. *In re Paulsen*, 31

USPQ2d 1671, 1673 (Fed. Cir. 1994); MPEP § 2131 (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). As is discussed above, Kayyem does not teach the claimed insulators. Accordingly, the Examiner has not carried her burden under §102(e), and Applicants respectfully request withdrawal of the rejection.


CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and early notification to that effect is respectfully requested. Please direct any calls in connection with this application to the undersigned attorney at (415) 781-1989.

Respectfully submitted,

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